

Image



PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Docket No: Q63961

Yasuo IWASA, et al.

Appln. No.: 09/841,486

Group Art Unit: 1771

Confirmation No.: 4521

Examiner: Hai VO

Filed: April 25, 2001

For: POROUS RESIN FILM AND INK JET RECORDING MEDIUM

STATEMENT OF SUBSTANCE OF INTERVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Please review and enter the following remarks summarizing the interview conducted on
February 12, 2004:

REMARKS

An Examiner's Interview Summary Record (PTO-413) was mailed on February 25, 2004.

During the interview, the following was discussed:

1. Brief description of exhibits or demonstration:

None

2. Identification of claims discussed:

Claim 1

3. Identification of art discussed:

Suzuki et al (U.S. 4,506,037)

4. Identification of principal proposed amendments:

None

5. Brief Identification of Applicants' principal arguments:

a. Suzuki et al does not specifically disclose "a thermoplastic resin comprising 5 to 100 parts by weight of a hydrophilic thermoplastic resin per 100 parts by weight of a non-hydrophilic thermoplastic resin" as recited in claim 1 of the present application. Therefore, Suzuki et al cannot be said to anticipate the claimed invention within the meaning of 35 U.S.C. § 102, since all elements of the claimed invention are not specifically disclosed. Further, it cannot be said that the arguments relating to the amount of the hydrophilic resin and the effect on the contact angle with water are invalid or irrelevant, since the amount of the hydrophilic resin cannot be disregarded.

b. The recited process elements of kneading the composition in an intermeshing twin extruder at the specified shear rate provide structural features to distinguish the claimed invention over the prior art. As stated in the previous response and in the disclosure of the present application, these claimed elements are essential features of the process for obtaining the claimed stretched porous film having the recited liquid absorptivity. Applicants have pointed out that if the screw shear rate is less than 300 sec^{-1} , then the hydrophilic resin will not be sufficiently dispersed and the desired liquid absorptivity would not be obtained. The liquid absorptivity is a recited physical or structural property of the claimed invention, which distinguishes over the prior art and which is obtained by the defined process. Therefore, the process elements should be

given weight and considered as positive elements of the claimed invention that distinguish the invention over the prior art since it has been held that a difference in physical properties of a claimed product attributable to a process limitation may also serve to distinguish the claimed invention over a prior art product.

c. The Examiner's contention that the claimed liquid absorptivity property is an inherent feature of the foam of Suzuki et al is not reasonably based. In the Advisory Action, the Examiner maintains the position that the liquid absorptivity property is inherent since the composition of Suzuki et al is the same as in the claimed invention. However, as previously pointed out, Suzuki et al does not disclose a thermoplastic resin comprising 5 to 100 parts by weight of a hydrophilic thermoplastic resin per 100 parts by weight of a non-hydrophilic thermoplastic resin as recited in the present claims. Therefore, it cannot be said that the composition disclosed by Suzuki et al is the same. Further the foam obtained by Suzuki et al is different from the stretched porous film of the claimed invention and the process for obtaining the disclosed foam is different from the process for obtaining the claimed stretched film. Even more specifically, Suzuki et al does not disclose the specified shear rate of 300 sec^{-1} or higher, which directly attributes to a liquid absorptivity within the claimed range. Therefore, it cannot be said that it "necessarily flows" from the teachings in the prior art that the foam disclosed by Suzuki et al inherently possess the recited liquid absorptivity property of the claimed invention.

d. With respect to the Examiner's contention that the claims do not recite an expansion ratio and therefore the micrographs are not persuasive, Applicants noted that

the micrographs and the arguments relating thereto were submitted to show that the foam of Suzuki et al is not stretched as is the film of the present invention. Therefore, since the present claims recite a “stretched” film, the evidence submitted is commensurate in scope with the claimed invention and should be sufficient to distinguish the claimed invention over the prior art.

e. In regard to the Examiner’s comments regarding the amendment to recite the phrase “consisting essentially of”, the phrase was included to exclude the aqueous medium used as a blowing agent in Suzuki et al. As stated in the Amendment filed on August 21, 2003, Suzuki et al describes the aqueous medium as “water” to which a surface active agent, water soluble polymer, polyhydric alcohol, water-miscible organic solvent, etc., *may be added*. See col. 6, lines 22-31. It appears, however, that the Examiner is misinterpreting Suzuki et al as disclosing a surface active agent, polyhydric alcohol and water-miscible organic solvent as examples of suitable alternatives to water as an aqueous medium. Thus, based on this apparent misinterpretation of the disclosure of Suzuki et al, the Examiner suggests that these components disclosed by Suzuki et al are not excluded. However, an aqueous medium as taught by Suzuki et al would have detrimental effects on the claimed invention and therefore is excluded, whereas the components disclosed by Suzuki et al as additives for the disclosed aqueous medium are not necessarily excluded. Therefore, it is not necessary for Applicants to provide declarative evidence that an additional component would affect the basic and novel characteristics of the claimed invention for all possible additives. Further, the evidence

in the specification, which is discussed in the last response, i.e., that a moisture content of 400 ppm or less is desirable and drying is carried out in advance in the Examples of the present specification, in order to control the content of moisture, is sufficient to establish that the addition of an aqueous medium as described by Suzuki et al to “hold the aqueous medium stably” (see col. 3, lines 58-60) would affect the basic and novel characteristics of the claimed invention. This is further supported by the disclosure of Suzuki et al which indicates that the use of water as a blowing agent as in the disclosed invention was never thought of before because it is a common practice in the art to use fillers for resins after water has been removed by drying. Col. 1, lines 56-59.

6. Indication of other pertinent matters discussed:

Applicants indicated that at least the rejection under 35 U.S.C. § 102 over Suzuki et al should be withdrawn to reduce the issues on appeal in view of the fact that Suzuki et al does not teach all elements of the claimed invention.

7. Results of Interview:

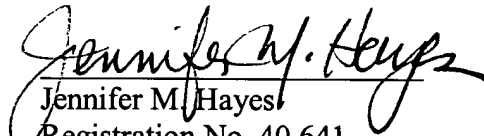
No agreement was reached and the Examiner requested Applicants to file an Appeal Brief or other appropriate written response so that the Examiner could fully consider all of the arguments made.

Statement of Substance of Interview
U.S. Application Ser. No. 09/841,486

Attorney Docket No. Q63961

It is believed that no petition or fee is required. However, if the USPTO deems otherwise, Applicant hereby petitions for any extension of time which may be required to maintain the pendency of this case, and any required fee, except for the Issue Fee, for such extension is to be charged to Deposit Account No. 19-4880.

Respectfully submitted,


Jennifer M. Hayes
Registration No. 40,641

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

23373

CUSTOMER NUMBER

Date: March 19, 2004